


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 21547-00268-US	
		Application Number 09/509,869-Conf. #1354	Filed June 15, 2000
		First Named Inventor Lennart Carlsson et al.	
		Art Unit 3764	Examiner N. D. Lucchesi
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>57,703</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p>		 _____ Signature R. James Balls _____ Typed or printed name	
		_____ (202) 331-7111 Telephone number May 15, 2007 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.			

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Lennart Carlsson et al.

Application No.: 09/509,869

Confirmation No.: 1354

Filed: June 15, 2000

Art Unit: 3764

For: ARRANGEMENT FOR OBTAINING
RELIABLE ANCHORING OF A THREADED
IMPLANT IN BONE

Examiner: N. D. Lucchesi

REASONS FOR REQUESTING PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The only issue remaining for appeal is an enablement rejection under 35 U.S.C. §112, first paragraph based on confusion regarding two specifications, an original specification and a corrected specification. In a May 3, 2007 Advisory Action, it was determined that the application was not in condition for allowance “because there are two specifications filed, both bearing the same WO and PCT numbers. Since there is still a question as to which specification is the original specification, the 112 1st paragraph rejection still applies.”

The original PCT application was timely corrected pursuant to PCT Article 34 and subsequently entered U.S. national stage on June 15, 2000. Applicants first drew the examiner’s attention to the corrected specification in remarks filed on February 8, 2007, as applicants came to suspect that the wrong specification was being referred to during examination. Applicants pointed to the corrected specification appearing in the USPTO’s “Image File Wrapper” and also submitted an additional copy for the examiner’s convenience. Subsequently, applicants contacted the examiner by telephone, directed him to the corrected specification, and requested

either a Notice of Allowability or an Advisory Action. The examiner responded with an Advisory Action explaining that he was unable to determine which application is the original since both bear the same WO and PCT numbers.

As explained in previous communications, the USPTO's "Image File Wrapper", contains the original and corrected specifications. Both documents are clearly marked. For example, the cover of the original specification (published before correction) has written on its face, "published with international search report. Before the expiration of the time limit for amending the claims and to be republished in the event of the receipt of amendments." Additionally, the top of pages 9 of the specification is stamped, "REPLACED BY ART 34 AMDT." Also, a search of the WIPO database provides both specifications. The top of the front page of the corrected version is stamped, "CORRECTED VERSION". Thus, it is clear, or can be easily determined, which application is the original and which is the corrected version.

The corrected version of the specification supports the claimed subject matter. The Examiner rejected the claims based on the original application, stating that the recitation of threads having a slight conicity, two sections of differing conicity, and the recitation of bone being forced out upon screwing of the implant in a hole in a bone are not described in the original specification so as to enable a person with skill in the art to make and/or use the invention.

Reference to the correct version of the specification, however, eliminates any enablement concern. For example, Figure 1 of the drawings illustrates two conicities 3d, 3e. The use of two conicities is also described in detail with reference to Figure 1, beginning at line 25 of page 11. Beginning at line 25, a threaded implant is described as having two conicities, with a thread 3d having a slight conicity angle α , and a thread 3e having a greater conicity angle β .

The specification also discusses the use of multiple thread spirals in detail. Beginning at line 13 of page 8 of the specification, a feature of the embodiments is described as choosing the number of thread spirals, which can be two, three or four. Figures 11 and 12 illustrate the multiple thread spirals, which are further described beginning at line 31 of page 13. Further, the

present specification describes that the introduction of multiple thread spirals, *per se*, is known. In addition, support for the claimed subject matter can be found in originally filed claims 1-15.

In light of the above specific but not exhaustive list of citations, the specification provides a full description of multiple conicities and thread spirals as claimed.

Also note that the functional recitation of bone being forced out upon screwing of the implant in a hole in a bone is also fully described in the specification particularly in the originally presented claims 1-15. Applicants point out that the claims, as filed, are part of the disclosure. The description of the implant structure is therefore sufficient to convey the described function to one of ordinary skill in the art.

Applicants remain committed to an expeditious resolution to this matter; and as always, applicants' agent is available by telephone for an interview if it would serve to assist in the resolution and allowance of this case.

Applicant believes no additional fee is due with this communication. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 21547-00268-US from which the undersigned is authorized to draw.

Dated: May 15, 2007

Respectfully submitted,

By 

Burton A. Amermick

Registration No.: 24,852

R. James Balls

Registration No.: 57,703

CONNOLLY BOVE LODGE & HUTZ LLP

1990 M Street, N.W., Suite 800

Washington, DC 20036

(202) 331-7111

(Fax)

Attorneys for Applicant